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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
UNDERDAHL, THANE E	

ART UNIT	PAPER NUMBER
1651	

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01/21/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/677,857	COOPER ET AL.	
	Examiner	Art Unit	
	THANE UNDERDAHL	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-57* is/are pending in the application.

4a) Of the above claim(s) *11,12 and 18-55* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,13-17,56 and 57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/17/08, 10/23/08, 12/03/08, 12/29/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Detailed Action

This Office Action is in response to the Applicant's request for continued examination received 10/17/08. Claims 1-57 are pending. Claims 11, 12 and 18-55 are withdrawn. No claims are cancelled. No claims have been amended. No claims are new.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/17/08 has been entered.

Response to Applicant's Arguments

In the response submitted by the Applicant the 35 U.S.C § 103 (a) rejection of claims 1-10 and 13-17, 56, 57 based on Ramirez et al. alone and in view of Kanios et al. and in further view of Bartnick et al. are withdrawn in light of the re-evaluation of evidence previously provided by the Examiner.

New Rejections

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10 as well as new claims 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramirez et al. (U.S. Patent # 5632996) in view of Self (U.S. Patent # 4917816).

These claims are drawn to a composition comprising particles of benzoyl peroxide (**BP**) or a salt thereof that is present in an amount from about 99.5% to about 0.001% by weight, wherein the particles have an average size of less than 2000 nm, and also contains a surface stabilizer is present in an amount of about 0.5% to 99.999% by weight. These particles can be in a crystalline phase, amorphous phase, a semi-crystalline phase, or a semi-amorphous phase. Claim 3 further limits claim 1 by requiring the BP particles be less than 1900 nm in size. Claim 4 limits the formulation of the composition in claim 1 to creams. The composition further comprises pharmaceutically acceptable excipients, carriers, or a combination thereof.

The surface stabilizer is selected from the group of non-ionic surface stabilizers. Claim 9 further limits that the composition of claim 1 comprises at least two surface stabilizers. Claim 10 provides a list to limit the surface stabilizers, some of which are ionic and non-ionic.

The Examiner notifies the Applicant that the use of "about" while not indefinite has a larger scope than the numbers that confine the size or amount of BP crystals in the composition. As such the limitations of the range being about less than about 1900 nm or 2000 nm or even about 99.5% to about 0.001% are much broader than the numbers specify. "About", as the Examiner interprets, adds both to the upper and lower limitations of a range, since in common use terms "about" does not limit a value in one

direction. For example, a pH of "about" 7 can reasonably be interpreted by as skilled artisan as 7.5 or 6.8. Indeed the term "about" also negates the limitation "less than" since "about less than" can include values slightly above the limitation of 2000 nm since these too are "about" 2000 nm.

Ramirez et al. teach a composition of BP that ranges from 70% to 5% by weight and a surface stabilizer of alkylbenzoate (**AB**) that ranges in the composition form 95% to 30% by weight (col 3, lines 50-65, and col 2, lines 59-68). These BP compositions can be formulated into a lotion, cream or gel (lines 29-31) or a solid dosage form such as a soap for use on the skin. The cream compositions contain other non-ionic surface stabilizers such as AB as well as colloidal silicon dioxide (col 4, line 40). The cream also contains pharmaceutically acceptable excipients and carriers such as glycolic acid and petrolatum (petroleum jelly).

Ramirez et al. also teach that their amorphous powder of BP is an art-defined equivalent to BP crystals in a cosmetic composition (col 3, line 28-46). Therefore it would be obvious for one of ordinary skill in the art to substitute one crystal phase of BP for another in a cosmetic formulation (M.P.E.P. § 2144.06).

Ramirez addresses particle size as important in the formulation by teaching "It would be desirable to provide a BP compositions…which have a smooth texture appropriate for cosmetic products" (col 1, lines 53-59) and BP "crystalline powder is gritty" and discusses the importance to "prepare a paste having benzoyl peroxide crystals that are sufficiently fine to be of acceptable texture for preparing products for

topical use" (col 1, lines 30-40). Therefore in light of the teachings if Ramirez et al. one of ordinary skill in the art would recognize the importance of crystal size in the texture of a BP composition, and that finer crystals are required to reduce the grittyness of the composition to make it acceptable for topical use. Therefore, one of ordinary skill in the art would be motivated to use small BP crystals from the teachings. However, Ramirez et al. does not teach the specific particle size of the BP in their composition as limited in the claims. However this would be obvious in view of Self et al.

Self et al. teaches small BP crystals of "from about 2 microns" (Self, col 9, line 14) as "active ingredients in dermicidal and other pharmaceutical compositions" (Self, col 3, lines 62-63). "About 2 microns" obviously meets the limitations of about 1900 or about 2000 nm as mentioned in the preceding paragraphs.

Therefore one of ordinary skill in the art would be motivated by both Ramirez et al. to use the BP crystals of Self et al. since Ramirez et al. desires the use of fine crystals in their skin compositions and Self et al. teach that their BP crystals are useful in dermicidal (skin) compositions. Furthermore, since both teach BP crystals one of ordinary skill in the art would recognize that it would be obvious to substitute the crystals of Self et al. in the composition of Ramirez et al. with reasonable expectation of success since both BP crystals have the same chemical composition and are both used in skin compositions ((KSR International v. Teleflex Inc. 550 U.S. ___, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007)).

Therefore the references listed above renders obvious claims 1-10 and new claims 56 and 57.

Claims 1-10 and 14-16, 56, 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramirez et al. (U.S. Patent # 5632996) and Self (U.S. Patent # 4917816) as applied to claim 1-10 above, and further in view of Kanios et al. (U.S. Patent # 5719197, 1998).

Claims 1-10 and new claims 56 and 57 are summarized above. Claims 14-16 further limit the composition of claim 1 by requiring the composition to be a bioadhesive, additionally comprise one or more non-BP active agents selected from the group of nutraceuticals, retinoic acid, antibiotics, sulfur and salicylic acid.

As mentioned above Ramirez et al. and Self et al. render obvious claims 1-10 above by teaching a BP composition with a several surface stabilizers that can be formulated into a cream for cleansing the skin (col 1, lines 10-13) which includes acne treatment (col 4, lines 55-60). However they do not teach the components of claims 13-17. These are taught in the by Kanios et al. Kanios et al. teach that their composition for topical applications of pharmaceutical agents and bioadhesive carriers can be formulated into an anti-acne composition containing BP and the additional active agent retinoic acid.

Since the anti-acne compositions of Ramirez et al. and Kanios et al. share common components to treat a common goal it would be obvious for one of ordinary skill in the art to add the composition of Ramirez et al. in view of Self et al. to the invention of Kanios. The motivation and reasonable expectation of success is provided by Kanios et al. who teach an anti-acne composition with similar components to

Ramirez et al. Therefore, the invention as a whole would have been prima facie obvious at the time of filing in view of the references listed above and as such claims 1-10 and 14-16, 56, 57 are not allowable.

Claim 1-10 and 13-17, 56, 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramirez et al., Self et al. and Kanios et al. as applied to claims 1-10 and 14-16, 56 and 57 above, and further in view of Bartnick et al. (U.S. Patent # 5,399,353, 1995).

Claims 1-10 as well as 14-16 are summarized above. Claim 13 further limits the composition of claim 1 by requiring the surface stabilizer is lysozyme, polyvinylpyrrolidone (**PVP**), benzalkonium chloride (**BKC**). Claim 17 limits the antibiotic to clindamycin or erythromycin.

Claims 1-10 are rendered obvious by Ramirez et al. in view of Self et al. Claims 1-10 and 14-16 are rendered obvious by the combination of Ramirez et al., Self et al. and Kanios et al. While Kanios et al. does teach the addition of antibiotics clindamycin and erythromycin as well as lysozyme and PVP to their composition the motivation to add these components to a skin cleansing composition is provided by Bartnick et al.

Bartnick et al. teach a composition to disinfect undamaged skin (col 7, lines 15-20). In this composition they include strong disinfectants such as BP, lactic acid as well as PVP and lysozyme (col 7 line 65 to col 8 line 2). Ramirez et al. already adds the disinfectants lactic acid and BP to their composition (col 4, lines 35-45) and M.P.E.P. § 2144.06 states

> "It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art."

Therefore it is *prima facie* obvious to one of ordinary skill in the art to add more disinfectants to the composition of Ramirez et al., Self et al. and Kanios et al. as motivated by Bartnick et al.

Bartnick et al. also teach the addition of antibiotics to a composition to clean skin (col 7, line 62). Bartnick et al. is silent on which antibiotic. However Kanios et al. teach that the antibiotics clindamycin and erythromycin can be added to their skin composition (col 16, lines 63-65). One of ordinary skill in the art would recognize that antibiotics would be useful in treating skin diseases cause by bacterial infections such as acne. It would therefore have been obvious for the person of ordinary skill in the art to add the antibiotics of Kanios to the combined composition of Ramirez et al., Self et al. and Kanios et al. The motivation is provided by Bartnick et al. who teach the additional components of a skin cleansing composition and the reasonable expectation of success is provided by the formulations of Kanios et al. Therefore, the invention as a whole would have been prima facie obvious at the time of filing in view of the references listed above and as such claims 1-10 and 13-17, 56, 57 are not allowable.

In summary no claims, as written, are allowed for this application.

In response to this office action the applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP § 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 U.S.C. § 102 or 35 U.S.C. § 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is requested to provide a list of all copending U.S. applications that set forth similar subject matter to the present claims. A copy of such copending claims is requested in response to this Office action.

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thane Underdahl whose telephone number is (571) 272-9042. The examiner can normally be reached Monday through Thursday, 8:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached at (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thane Underdahl
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/Leon B Lankford/
Primary Examiner, Art Unit 1651